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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
MICHAEL C. SCROGGIE ET AL.

:
: GROUP: 3622

APPLICATION NUMBER: 09/401,939

: EXAMINER: GRAVINI, S

FILED: September 23, 1999

:

FOR: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES
TO CUSTOMERS THROUGH A COMPUTER NETWORK

37 CFR 1.193 REPLY BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Sir: In reply to the new points raised by the examiner's answer mailed August 25, 2003,
please consider the following.

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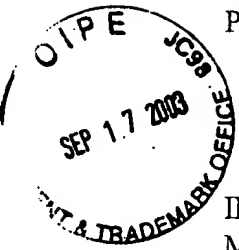


TABLE OF CONTENTS

I.	Filing Date of Related Appeals and Interferences	1
II.	The Claims do not Stand or Fall Together	1
III.	The Examiner Simplified His Anticipatory and Double Patenting Rejections	1
IV.	The Examiner Admits that all Anticipation Rejections of Claims 32-70 Based Upon Von Kohorn, Ferguson et al., and Deaton et al. are not Sustainable	2
V.	The Examiner Admits that all Obvious-Type Double Patenting Rejections of Claims 32-70 Based Upon Claims 1-10 of U.S. Patent No. 6,185,541 are not Sustainable ...	2
VI.	The Examiner Admits that all Obviousness Rejections of Claims 32-70 Based Upon Copen ding Application Nos. 09/478,351 and 09/716,404 are not Sustainable	3
VII.	Claims 32-70 Remain on Appeal	3
VIII.	The Examiner's Modifications to his Arguments in the Examiner's Answer Mailed August 25, 2003	4
A.	Claim Rejections of Claims 32-70 Under 35 USC 112, Second Paragraph ...	4
B.	Claim Rejections of Claims 32-70 Under 35 USC 103 Based Upon an Obvious Variation of Examiner's Personal Knowledge of Consumer Purchase Incentive Distribution Provided by PerformanceBike	5

I. Filing Date of Related Appeals and Interferences

At page 2 lines 4-10, Examiner Gravini requests the “filing date of the related appeals and interferences be submitted as specified under rule 192(c)(2).” In response, applicants submit the following filing dates for all related appeals and interferences:

1. US Application No.: 09/716,404 (Neifeld Ref.: CAT/29-SCROCO4) appeal brief filed January 29, 2003.

2. US Application No.: 09/401,198 (Neifeld Ref.: CAT/29US-SCROD1) appeal brief filed October 9, 2001.

3. US Application No.: 09/410,086 (Neifeld Ref.: CAT/29US-SCROD2) appeal brief filed November 14, 2002.

4. US Application No.: 09/567,274 (Neifeld Ref.: CAT/29-SCROCO3) appeal brief filed January 28, 2003.

II. The Claims do not Stand or Fall Together

In the examiner’s answer, Examiner Gravini concluded that:

The appellant’s statement in the brief that certain claims do not stand or fall together is not agreed with because it is considered that appellants have not explained why claims of the groups are believed to be separately patentable.
[Page 3 lines 3-5.]

In reply, the appellants submit that reasons supporting the appellants’ assertion that rejections of each group of claims do not stand or fall together are provided for each groups of claims on page 24 line 37 through page 25 line 3 of the appeal brief. Accordingly, the propriety of the rejections must be decided by the Board for each group of claims identified by the appellant based upon the applicant’s reasons for each group of claims, regardless of the examiner's conclusion.

III. The Examiner Simplified His Anticipatory and Double Patenting Rejections

In the examiner’s answer, in regard to the issues in the brief, Examiner Gravini made the following change:

[t]he anticipatory and double patenting rejections have been simplified to a single reference with respect to each rejection. [Page 2 lines 20-21.]

IV. The Examiner Admits that all Anticipation Rejections of Claims 32-70 Based Upon Von Kohorn, Ferguson et al., and Deaton et al. are not Sustainable

At page 6 lines 7-9 in the final office action, mailed November 11, 2002, the examiner indicated that:

Claims 32-70 are rejected under 35 USC 102(b) as being clearly anticipated by von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), Deaton et al. (US 5,430,644), OR Day et al. (US 5,857,175).

At page 5 lines 14-15 in the answer, the examiner indicated that:

Claims 32-70 are rejected under 35 USC 102(b) as being clearly anticipated by Day et al. (US 5,857,175).

The examiner did not repeat or support the rejections of claims 32-70 based upon von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), and Deaton et al. (US 5,430,644), which were applied to reject claims 32-70 in the final office action. Thus, the statement in the answer is an admission by the examiner that the rejections of claims 32-70 under 102(b) based upon von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), and Deaton et al. (US 5,430,644), which were included in the final office action, but were NOT included in the examiner's answer, are not sustainable. Therefore, the Board should enter a decision reversing the rejections of claims 32-70 based upon each one of von Kohorn, Ferguson et al., and Deaton et al.

V. The Examiner Admits that all Obvious-Type Double Patenting Rejections of Claims 32-70 Based Upon Claims 1-10 of U.S. Patent No. 6,185,541 are not Sustainable

At page 9 lines 10-12 in the final office action, mailed November 11, 2002, the examiner indicated that:

Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-10 of U.S. Patent No. 6,185,541.

At page 8 lines 6-7 in the answer, the examiner indicated that:

Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469.

The examiner did not repeat or support the rejections of claims 32-70 based upon claims 1-10 of U.S. Patent No. 6,185,541, which were applied to reject claims 32-70 in the

final office action. Thus, the statement in the answer is an admission by the examiner that the rejections of claims 32-70 for obviousness-type double patenting based upon claims 1-10 of U.S. Patent No. 6,185,541, which were included in the final office action, but were NOT included in the examiner's answer, are not sustainable. Therefore, the Board should enter a decision reversing the rejections of claims 32-70 based upon claims 1-10 of U.S. Patent No. 6,185,541.

VI. The Examiner Admits that all Obviousness Rejections of Claims 32-70 Based Upon Copending Application Nos. 09/478,351 and 09/716,404 are not Sustainable

At page 9 lines 17-18 in the final office action, mailed November 11, 2002, the examiner indicated that:

Claims 32-70 are rejected under 35 USC 103(a) as being obvious over copending Application Nos. 09/478,351 or 09/567,274 or 09/716,404.

At page 8 lines 12-13 in the answer, the examiner indicated that:

Claims 32-70 are rejected under 35 USC 103(a) as being obvious over copending US Patent Application 09/567,274.

The examiner did not repeat or support the rejections of claims 32-70 based upon copending Application Nos. 09/478,351 or 09/716,404, which were applied to reject claims 32-70 in the final office action. Thus, the statement in the answer is an admission by the examiner that the rejections of claims 32-70 for obviousness based upon copending Application Nos. 09/478,351 and 09/716,404, which were included in the final office action, but were NOT included in the examiner's answer, are not sustainable. Therefore, the Board should enter a decision reversing the rejections of claims 32-70 based upon copending Application Nos. 09/478,351 and 09/716,404.

VII. Claims 32-70 Remain on Appeal

The examiner has no authority to "remove" claims from an appeal. The examiner would have had to reopen prosecution to withdraw any rejections of claims 32-70. MPEP 1208.01 and 37 CFR 1.195. The examiner has not reopened prosecution and accordingly, the final rejections of all claims remain and are appealed. Therefore, the Board should decide and presumably reverse all of the rejections that the examiner admits are improper.

Moreover, the appellant has a right to a decision on appeal to obtain finality and repose on the issue of patentability for claims 32-70. Therefore, the Board should decide and

presumably reverse the rejections of these claims.

Finally, the Board should review and reverse admittedly improper rejections in view of the impact a decision reversing all rejections of any claim would have on patent term. 35 USC 154.

VIII. The Examiner's Modifications to his Arguments in the Examiner's Answer Mailed August 25, 2003

A. Claim Rejections of Claims 32-70 Under 35 USC 112, Second Paragraph

In the examiner's answer, Examiner Gravini modified his argument, stating that:

The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the *each [sic] claim reciting that feature does not provide an antecedent basis of transmitting selected data or generating token data. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the claims, and as such,* it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. [Examiner's Answer page 4 line 22 through page 5 line 7; italics added.]

Previously, Examiner Gravini had stated that:

The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the *specification does not provide an antecedent basis of transmitting selected data or generating token data. Since the specification does not provide an antecedent basis for these critical independently claimed steps, the independently claimed invention is not described in the specification such that* it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. [Final office action mailed November 22, 2002 page 5 lines 12-20; italics added.]

In the examiner's answer, Examiner Gravini explained the reason for the change, stating that:

Finally, the argument with respect to the second paragraph rejection above has been editorially modified to more properly identify the claim

language with respect to the statute. [Page 11 lines 7-9.]

In reply, the appellants point out that the change in this rejection is substantive, not editorial. However, the examiner still fails to explain why he thinks any claim is indefinite. Accordingly, these rejections should be reversed.

Nevertheless, appellants' brief pages 8 and 9 identify unequivocal support for the limitations relating to "selection data" "token data."

B. Claim Rejections of Claims 32-70 Under 35 USC 103 Based Upon an Obvious Variation of Examiner's Personal Knowledge of Consumer Purchase Incentive Distribution Provided by PerformanceBike

In the examiner's answer, Examiner Gravini modified his argument, stating that:

Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to customers, that it would have been obvious to claim the invention as recited by the applicant *by substituting terms with patentably equivalent claim language*, in order to overcome the explicit teachings of the *examiner's experienced* prior art. [Page 7 lines 12-17; italics added.]

Previously, Examiner Gravini had stated:

Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the *published* prior art. [Final office action mailed November 22, 2002 page 8 lines 15-18; italics added.]

In reply, appellants do not understand what "substituting terms with patentably equivalent claim language" means and presume that the Board will also be lost.

In the examiner's answer, Examiner Gravini added the italicized portion to the following passage to his argument, relative to his argument in the final office action:

Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. *It is considered that the claim recitations using "computer" are an attempt to automate an old and well known process provided by PerformanceBike.* [Page 7 lines 17-22; italics added.]

In the examiner's answer, Examiner Gravini explained the reason for the addition, stating that:

The rejection above has been modified to clarify interpretation of the obviousness rejection and hopefully fully answer appellant's arguments. [Page 14 lines 13-15.]

In reply, the appellants submit that the examiner's new reasoning does not provide motivation to modify his experience in a retail store of Performance Bike, Inc, to result in the claimed inventions.



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PATENT TRADEMARK OFFICE

9/16/03
Date

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